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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/990,929 | 11/16/2001 | Jheroen Pieter Dorenboch | PN1019AA/10-32 | 3487 |

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EXAMINER

NGUYEN, TOAN D

ART UNIT PAPER NUMBER

2665

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,929

Applicant(s)

DORENBSOCH, JHEROEN
PIETER

Examiner

Toan D Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-10 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3-5 is/are objected to.
- 8) ☒ Claim(s) 11-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/16/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, drawn to a method of independently managing membership for a group and mobility for members of that group, classified in class 370, subclass 312.
 - II. Claims 11-20, drawn to a method of using a call initiation protocol to set up a conference call on a conference device, classified in class 370, subclass 260.
2. The inventions are distinct, each from the other because: Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as managing membership for a group and mobility for members of that group, and invention II has separate utility such as using a call initiation protocol to set up a conference call on a conference device. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Charles W. Bethards on March 30, 2005 a provisional election was made with traverse to prosecute the invention of group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 11-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37.CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

6. Claims 2-4, 6 and 8-9 are objected to because of the following informalities:

In claim 2 line 1, it is suggested to change "a group name" to --- said group name ---.

In claim 3 line 4, "said register" seems referring back to "a registrar" in line 3 of the claim rather than "a registrar" in claim 1 line 4. If it is true, it is suggested to change "a registrar" (claim 3 line 3) to --- a second registrar ---.

In claim 4 line 1, it is suggest to change "a name" to --- said name ---.

In claim 6 line 7, it is suggested to change "a session" to --- said session ---.

In claim 6 line 11, it is suggested to change "a session" to --- said session ---.

In claim 8 line 1, it is suggested to change "a session" to --- said session ---.

In claim 9 line 2, it is suggested to change "a session" to --- said session ---.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maggenti et al. (US 6,477,150) in view of Nuutinen (US 6,865,681).

For claim 1, Maggenti et al. disclose system and method for mobile station authentication using session initiation protocol (SIP) comprising the steps of:

setting up, a group (a net means) name (reference sip:<net>@<nbsdomain>) (col. 8 lines 53-60 and col. 9 lines 1-7) and a membership for that group (col. 4 lines 64-66 and col. 5 lines 5-11); and

establishing, separately from said membership, contact information associated with each of said plurality of names (figure 6, reference CM 218, col. 17 lines 7-11 and col. 17 lines 14-58).

However, Maggenti et al. do not expressly disclose in a registrar and that group including a plurality of names, each of said plurality of names indicative of a user within that group. In an analogous art, Nuutinen discloses in a registrar (col. 5 lines 19-23), and a membership for that group including a plurality of names, each of said plurality of names indicative of a user within that group (col. 5 lines 36-43).

One skilled in the art would have recognized a registrar in setting up, and would have applied Nuutinen's registrar process for session initiation protocol (SIP) in Maggenti et al.'s control setup and control signaling between CDs and CM 218. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Nuutinen's VOIP terminal security module, SIP stack with security manager, system and security methods in Maggenti et al.'s system and method for providing group communication services in an existing communication system with the motivation being to provide a server that accepts REGISTER requests, by which users can register their location with SIP servers (col. 5 lines 20-21).

For claim 2, Maggenti et al. disclose wherein said step of setting up a group name and establishing said contact information is compatible with a Session Initiation Protocol (SIP) (col. 8 lines 53-60 and col. 17 lines 7-58).

Allowable Subject Matter

10. Claims 3-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 6-10 are allowed.

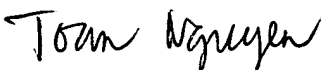
12. The following is an examiner's statement of reasons for allowance:

Regarding claim 6, the prior art fails to teach a combination of the steps of:
a second registrar associated with said each of said names;
forwarding said request for a session to said second register associated with said each of said names, said second registrar including a contact for said member, said contact indicative of a location associated with said member; and
forwarding said request for a session to said location associated with said member, in the specific combination as recited in the claim.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan D Nguyen whose telephone number is 571-272-3153. The examiner can normally be reached on M-F (7:00AM-4:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Toan Nguyen